

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Hyun-Jeong KIM

Group Art Unit: 2686

Serial No.: 09/734,852

Examiner: LY, Nghi H.

Filed: December 11, 2000

Docket: 678-578 (P9616)

Date: November 13, 2007

**For: METHOD OF NOTIFYING A CALLER OF MESSAGE
CONFIRMATION IN A WIRELESS COMMUNICATION SYSTEM**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

In response to the Examiner's Answer mailed September 13, 2007¹, Appellant respectfully submits that based on at least the arguments provided in the Amended Appeal Brief of May 21, 2007, Claims 16-27 are patentable over the applied references. The following comments are respectfully submitted in order to address statements made in the Examiner's Answer.

The Examiner raises no new grounds for rejection in the Examiner's Answer.

The allegations raised in the Examiner's Answer do not change the fact that independent Claim 16 is patentable over John, in view of Itoh, and further in view of Choksi, and that independent Claim 21 is patentable over John in view of Itoh.

1. The invention as claimed in the present application

Throughout prosecution, Appellants have maintained that the "answer signal" of Itoh is not

and cannot be equated with the “confirmation message” of the claims of the present application. The confirmation message of the present application is generated and sent “if a called party of the called mobile station has confirmed the received message”. It is the called party, i.e. a user, which causes the confirmation message to be generated. When the called party (again, the user) confirms the received message, the confirmation message is generated. The confirmation message indicates to the user of the calling mobile station that the user of the called mobile station has confirmed that the message has been received. That is, the calling party knows that the called party is aware of the message.

2. No combination of John, Itoh, and Choksi discloses the confirmation message of the claims of the present application

The Examiner equates the “answer signal” of Itoh with the “confirmation message” of the claims of the present application.² The reliance on Itoh for disclosing the confirmation message of the claims of the present application is in error.

Itoh describes its “answer signal” as a signal sent by and from a called mobile terminal³ when a called mobile terminal verifies that it has correctly received a message.⁴ Upon receipt of an answer signal, a calling party verifies that the message has reached the called mobile station.⁵ That is the calling party is aware that the message has arrived at the called mobile terminal. The answer signal of Itoh, however, does not indicate to the calling party if the user of the called mobile terminal is aware of the message. The answer signal of Itoh does not indicate to the calling party that the user of the called mobile terminal has confirmed receipt of the message.

The answer signal of Itoh is not and cannot be equated with the confirmation message of the claims of the present application.

¹ It is noted that the “Mail Date” on the Office Communication page is listed as September 13, 2007, but the stamp on the cover page of the Examiner’s Answer states that the Examiner’s Answer was mailed on September 11, 2007. This discrepancy is duly noted.

² See e.g. Examiner’s Answer at page 9.

³ Itoh at col. 5, lines 3-4.

⁴ Itoh at col. 5, lines 2-3.

⁵ Itoh at col. 5, lines 5-6.

3. Conclusion

Based on at least the foregoing, as the Examiner has failed to make out a prima facia case for an obviousness rejection, the rejection of Claims 16 and 21 must be reversed.

It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.

The Examiner has failed to show that all of the recitations of Claim 16 are taught in or suggested by the prior art. The Examiner has failed to make out a prima facia case for an obviousness rejection.

The Examiner has failed to show that all of the recitations of Claim 21 are taught in or suggested by the prior art. The Examiner has failed to make out a prima facia case for an obviousness rejection.

Independent Claim 16 is not rendered unpatentable by John in view of Itoh and Choksi, thus Claims 16-20 are allowable.

Independent Claim 21 is not rendered unpatentable by John in view of Itoh, thus Claims 21-27 are allowable.

Dated: November 13, 2007

By: 

Michael J. Musella
Reg. No.: 39,310
Attorney for Appellant

THE FARRELL LAW FIRM, P.C.
333 Earle Ovington Blvd., Suite 701
Uniondale, New York 11553
(516) 228-3565 (tel)
(516) 228-8475 (fax)